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In re Application of
Jonathan S. Stamler et al
Serial No.: 08/796,164
Filed: February 6, 1997
Attorney Docket No.: DUK96-03pA3

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: PETITION DECISION
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This is in response to applicants' petition under 37 CFR 1.144, filed April 26, 1999, requesting withdrawal of an improper restriction requirement.

A review of the file history shows that this application was filed under 35 U.S.C. 111 and is a CIP or CON or DIV of a number of earlier filed cases having an earliest filing date of September 15, 1995. In a first Office action, mailed January 13, 1998, the examiner set forth a restriction requirement under 35 U.S.C. 121, dividing the claims 1-62 into fourteen groups. Applicants elected Group IV and traversed the requirement with respect only to Group VI. On July 6, 1998, the examiner mailed a second Office action acknowledging the elected group and answering applicants' arguments for traversal of the requirement. Applicants replied timely and canceled all non-elected claims (including those of Group VI), amended, *inter alia*, claims 42, 45 and 46 and added claims 63-68. In a Final Office action mailed March 30, 1999, the examiner set forth a supplemental restriction requirement for claims 42, 45-46 and 63-68 arguing that they were now drawn to an invention non-elected by original presentation. The examiner alleges that the claims as now amended are drawn to methods which differ from the original method claims with respect to method objective or reaction conditions requiring burdensome additional manual and computer searches. Since the action was made Final, the new restriction requirement was inherently made Final causing applicants to file this petition.

A comparison of the claims in question with other pending claims does not support the examiner's position. For instance, amended claims 42 and 46 appear to be within the scope of claims 11-12 and 14-15. Similarly, claims 63-68 appear to be within the scope of other pending claims and differ only in the addition of a further limitation to further define over the applied art. Applicants specifically point to support in the specification for the amended and added claims, as required

DECISION

Applicants' petition is **GRANTED**. The restriction requirement set forth in the last Office action and made final in the last Office action is withdrawn. The last Office action is hereby vacated.

The application will be returned to the examiner for consideration of the claims held withdrawn from consideration and preparation of a new Office action.

Any request for reconsideration of this decision or a renewed petition must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely. Extensions of time may be available under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600/2900, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-5408.

A handwritten signature in black ink, appearing to read "John Kittle", with a stylized flourish underneath.

John Kittle
Director, Technology Center 1600/2900